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Supreme Court, U.S.
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No. 02-482

IN THE
Supreme Court of the United States
OCTOBER TERM, 2002

DESERET BOOK COMPANY; DEAN HUGHES,

Petitioners,

v.

GENE S. JACOBSEN,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Tenth Circuit

REPLY TO BRIEF IN OPPOSITION

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INTRODUCTION

In his opposition, respondent seeks to avoid the bedrock reality presented by the Tenth Circuit's opinion: certainty and clarity are vitally needed in this burgeoning area of litigation. Certainty and clarity in the operative rules of copyright are not only important for our system of free expression, but also of vast commercial significance. Ideas, information, and creative expression increasingly constitute important forms of property. The Tenth Circuit's decision, which allows respondent's claim of infringement of his copyrighted historical work to proceed on the basis of only minimal, if any, appropriation of expressive elements, would not only destabilize the law, but also have a substantial chilling effect on authors and publishing houses alike.

I. The Tenth Circuit Based Its Holding As To Substantial Similarity On Only Minimal, If Any, Appropriation Of Expressive Elements.

In order to play down the inconsistency between the Tenth Circuit's decision and earlier decisions of this Court and other courts of appeals, respondent devotes a substantial portion of his brief in opposition to recharacterizing what the Tenth Circuit actually held.[1] Respondent's dogged efforts notwithstanding, however, it is clear that the Tenth Circuit held that a subsequent work could be sufficiently "similar" to a copyrighted historical work

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[1] In an effort to cast petitioners in the worst equitable light, respondent also makes a number of factual representations regarding how he learned of petitioners' use of his story in the *Children of the Promise* series, including representations regarding what happened at a 1994 meeting between respondent and petitioner Hughes. *See* Opp. 1-4. As the district court and Tenth Circuit both noted, however, "what happened at the meeting and thereafter is heavily disputed by the parties." Pet. 18a, 31a. Petitioners continue hotly to contest the accuracy of respondent's representations. Even assuming they are true, however, they are legally irrelevant here because they relate only to the Tenth Circuit's ruling that respondent's claims were not barred by laches—a ruling that is not before this Court on *certiorari*.

even where the appropriation of expressive elements, if any, is minimal.

Respondent attempts to recast the Tenth Circuit's opinion in two principal ways. *First*, respondent suggests that the Tenth Circuit based its ruling on "*several lengthy examples* * * * of verbatim copying by Petitioners." Opp. 1 (emphasis added). Indeed, this characterization pervades respondent's brief. *See id.* at 5, 8, 14, 15, 17, 18, 22, 24, 25, 26. As noted in the petition, however, the Tenth Circuit in fact cited only *one* example of verbatim copying—involving a passage of respondent's memoir in which he described his journey to unite with American troops after the end of World War II. *See* Pet. 7-8. Indeed, even as to the passage in question, the Tenth Circuit stated only that the passage *might* contain protected expression—not that it actually did. *See id.* at 14a.

It is true, as respondent points out, that the Tenth Circuit, in a series of footnotes, quoted three other parallel passages in which the two works at issue recounted similar events. *See id.* at 10a n.7; *id.* at 11a n.8; *id.* at 12a n.9. Contrary to respondent's suggestion, however, the Tenth Circuit did not "f[i]nd that *in many instances* Hughes copied *verbatim* whole passages * * * from Dr. Jacobsen's memoir." Opp. 8 (first emphasis added). To the contrary, the Tenth Circuit listed these three passages only as examples of "paraphrasing," not verbatim copying, *see* Pet. 12a, and ultimately rested its conclusion on substantial similarity *solely* on the single example of verbatim copying, not on any of the examples of paraphrasing, *see id.* at 15a.

Second, respondent suggests that the Tenth Circuit concluded that petitioners appropriated respondent's protected expression by copying the *arrangement* of otherwise unprotected language. *See* Opp. 21, 23. To be sure, this Court has held that a factual compilation can be entitled to copyright protection to the extent that the facts are arranged in an original manner. *See Feist*

Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 348-49 (1991). Even assuming, however, that respondent could claim originality in what was ostensibly a chronological arrangement of historical facts, *cf. id.* at 363 (rejecting claim of originality in alphabetical arrangement of names in telephone directory), the Tenth Circuit said nothing about the *arrangement* of the language that was allegedly copied verbatim. Instead, it based its holding as to substantial similarity entirely on its conclusion, drawn from the single example cited in the opinion, that petitioners "*arguably* copied *more than a few* words and phrases." Pet. 14a (emphasis added).

In sum, the Tenth Circuit allowed respondent's claim to proceed solely because petitioners allegedly copied words and phrases from a single brief passage in the copyrighted work—words and phrases which themselves were arguably not even protected expression. The Tenth Circuit's holding—that a subsequent work could be sufficiently "similar" to a copyrighted historical work even where the appropriation of expressive elements, if any, is minimal—is in tension with this Court's prior decisions and conflicts with decisions of other courts of appeals.

II. Respondent Fails To Distinguish The Cases On Which Petitioners Rely.

Respondent does not, because he cannot, challenge the fact that this Court has frequently granted *certiorari* on important issues of copyright law even where there is no direct circuit conflict. *See* Pet. 2, 13. Nor does he challenge the importance of the question presented. *See id.* at 16-17. Instead, he contends only that the Tenth Circuit's decision is not in tension with this Court's prior decisions or in conflict with decisions of other courts of appeals. To a large extent, respondent's arguments depend on his recharacterization of what the Tenth Circuit actually held. *See, e.g.*, Opp. 14-15 (asserting that "[t]he Tenth Circuit's decision is not in conflict with *Harper & Row*" because "[t]he Tenth Circuit found

evidence demonstrating that Hughes copied verbatim *significant portions* of Dr. Jacobsen's individualized expression" and because "it found that Hughes copied *entire passages and portions* of Dr. Jacobsen's memoir") (emphasis added). To the extent they do not, however, respondent's arguments still fail.

Respondent begins by contending that the Tenth Circuit's decision is consistent with this Court's prior decisions in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), and *Feist*. As to *Harper & Row*, respondent remarkably asserts that "nothing in the decision requires a court to 'abstract' the unprotected facts from the protected expression of a copyrighted work." Opp. 14. To be sure, in *Harper & Row*, this Court did not specify a particular *method* for distinguishing unprotected fact from protected expression: indeed, the Court expressly noted that, "[e]specially in the realm of factual narrative, the law is currently unsettled regarding the ways in which uncopyrightable elements combine with the author's original contributions to form protected expression." 471 U.S. at 548. Nowhere, however, did either the majority or dissenting opinion suggest that a reviewing court should make *no* effort to separate unprotected fact and protected expression. *See, e.g., Harper & Row*, 471 U.S. at 582 (Brennan, J., dissenting) (noting that "infringement of copyright must be based on a taking of literary form, as opposed to the ideas or information contained in a copyrighted work"). Because the Tenth Circuit merely searched the two works for examples of *verbatim copying*, without making any effort to identify *protected expression*, its decision is in tension with *Harper & Row*.[2]

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[2] Respondent also points out that Justice Brennan, in concluding in his *Harper & Row* dissent that there was no substantial similarity, relied heavily on the facts that the allegedly infringing work did not *paraphrase* substantial portions of the copyrighted work and that the allegedly infringing work did not *arrange* the information presented in the same order. *See* Opp. 12-13. Petitioners are not contending, however, that the Tenth

(continued...)

As to *Feist*, respondent contends that "[p]etitioners argue that *Feist* establishes that in the context of all factual works, only verbatim * * * copying of the author's original expression gives rise to a claim of copyright infringement." Opp. 15. As petitioners have already acknowledged, however, *see* Pet. 11, this Court expressly recognized in *Feist* that, even absent the addition of original expression to underlying facts, an entirely factual compilation could be protected to the extent that facts are arranged in an original manner, *see* 499 U.S. at 348-49. It is therefore not true, as respondent wrongly accuses petitioners of claiming, that the *only* way a work can receive copyright protection is if unprotected facts are "abstracted" and protected expression remains. However, where, as here, the reviewing court does not conclude that a work is protected because it contains an original *arrangement* of unprotected material, the court must make some effort to *identify* protected expression. Because the Tenth Circuit failed to make that effort, its decision is in tension with *Feist*.

Respondent's efforts to distinguish the court of appeals cases on which petitioners rely are no more availing. Respondent contends that the Ninth Circuit's decision in *Narell v. Freeman*, 872 F.2d 907 (1989), is somehow consistent with the Tenth Circuit's decision here because the defendant in *Narell* copied only "ordinary isolated phrases" and not a "*sequence* of creative expression" from the plaintiff's work. Opp. 19 (emphasis added). As discussed above, however, the Tenth Circuit did not rely on any

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[2] (...continued)
Circuit's decision is inconsistent with Justice Brennan's dissent in either of these respects, since the Tenth Circuit did not reach either of these issues. Instead, petitioners assert merely that the Tenth Circuit's opinion is inconsistent with Justice Brennan's statements, unchallenged by the *Harper & Row* majority, that mere "linguistic similarities," in and of themselves, are insufficient to give rise to infringement, *see* 471 U.S. at 585 (dissenting opinion), and that no copyright can be asserted in the verbatim representation of the quoted statements of others, *see id.* at 586 n.10.

determination that petitioners copied a particular *arrangement* of otherwise unprotected material in concluding that the works were sufficiently "similar" to give rise to a claim of infringement. Indeed, to the extent that respondent contends that the arrangement of words and phrases *within the quotation* on which the Tenth Circuit relied constitutes protected expression, respondent fails even to address whether a *quotation* from another person can constitute protected expression *at all*. *See* Pet. 12-13 & n.4.

Respondent next attempts to distinguish the Second Circuit's decision in *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (1966), *cert. denied*, 385 U.S. 1009 (1967), ostensibly on the ground that the Second Circuit erroneously focused on whether the duplicated language constituted a substantial portion of the *infringing* work, rather than the *infringed* work. *See* Opp. 21-22. In fact, however, the Second Circuit stated that there was considerable doubt as to whether the duplicated language constituted a substantial portion of *either* the infringing *or* the infringed work. *See* 366 F.2d at 306. The court proceeded to find that the copying of two direct quotations and one eight-line paraphrase was insufficient evidence of infringement to warrant the entry of a preliminary injunction. *See id.* At a minimum, that determination is in tension with the Tenth Circuit's determination that the copying of isolated commonplace phrases in a *single* quotation suffices to allow a claim of infringement to go forward.

As for the Second Circuit's decision in *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974, *cert. denied*, 449 U.S. 841 (1980), respondent feebly dismisses that case on the ground that *Hoehling* sanctioned only the "random" duplication of words and phrases, whereas the Tenth Circuit found that petitioners' copying was not random. *See* Opp. 22-23. It is clear, however, that the Second Circuit used the term "random" synonymously with "incidental," not with "non-intentional"—especially since intent is not an element of copyright infringement. *See Buck v. Jewell-La*

Salle Realty Co., 283 U.S. 191, 198 (1931). Because the Tenth Circuit's opinion relied only on incidental copying of protected material (to the extent that material was protected at all), it is in conflict with *Hoehling*.

Finally, respondent suggests that *Nash v. CBS, Inc.*, 899 F.2d 1537 (7th Cir. 1990), is entirely inapposite because it involved the alleged appropriation only of a plot line, not of particular language. *See* Opp. 24-25. That is true, as petitioners have already conceded. *See* Pet. 16. Nevertheless, Judge Easterbrook's broad reasoning in *Nash* as to the lower degree of protection given to historical works is applicable to the incidental appropriation of expressive elements, as well as the appropriation of plot lines. Respondent offers no explanation as to why this reasoning should pertain only to the latter and not the former.[3]

The Tenth Circuit's decision here is contrary to the overwhelming weight of authority, both from this Court and from other courts of appeals. *Certiorari* is therefore warranted.

III. The Procedural Posture Of This Case Is No Bar To Review.

In a final throw of the dice, respondent contends that this Court should wait for another case in which to address the question presented because this case arises in the posture of review of denial

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[3] Respondent also contends that the Tenth Circuit's decision is consistent with the Second Circuit's decision in *Salinger v. Random House, Inc.*, 811 F.2d 90 (1987). In *Salinger*, however, the Second Circuit—in the context of determining the "amount and substantiality" of the portion used for purposes of applying the *fair use doctrine*—noted that the allegedly infringing work *paraphrased* the copyrighted work so closely as to constitute infringement. *Id.* at 98. Because the Tenth Circuit here rested its conclusion on substantial similarity solely on the single passage containing verbatim copying, it expressly left open the question whether close paraphrasing can give rise to substantial similarity—citing *Salinger* in the process. *See* Pet. 15a.

of a motion to dismiss. *See* Opp. 26. Although it is true, as the Tenth Circuit recognized, that substantial similarity is ultimately a question for the jury, *see* Pet. 7a, judges are obligated to determine both whether the copyrighted work contains protected expression and, if so, whether the two works are sufficiently similar as a matter of law for the case to proceed to the jury in the first place, *see, e.g.*, *Warner Bros. Inc. v. American Broad. Cos.*, 720 F.2d 231, 245 (2d Cir. 1983) (noting that "[c]ourts have an important responsibility in copyright cases to monitor the outer limits within which juries may determine reasonably disputed issues of fact"). Indeed, all of the courts of appeals cases with which the Tenth Circuit's decision conflicts arose at the preliminary-injunction or summary-judgment stage. *See Nash*, 899 F.2d at 1539; *Narell*, 872 F.2d at 909; *Hoehling*, 618 F.2d at 977; *Rosemont Enterprises*, 366 F.2d at 304.[4] And review is particularly appropriate where, as here, the courts below had before them not only the complaint, but also the copyrighted and allegedly infringing works themselves—all that is ever required to determine whether the two works are substantially similar or not. *See* Pet. 3a-4a. There is nothing to wait for; this case is ready for this Court's review now.

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[4] Moreover, this Court recently decided a trademark case presenting a similar question in the posture of review of denial of a motion for judgment as a matter of law. *See Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 208 (2000).

CONCLUSION

For the foregoing reasons, this Court should grant the petition for writ of *certiorari*.

Respectfully submitted,

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